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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,336	12/28/1998	GUY A. STORY JR.	02541.P009	3308

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 02/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

1/AG

Office Action Summary

Application No.

09/222,336

Applicant(s)

Story et al.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 24, 2002

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8, 10-18, and 20-30 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8, 10-18, and 20-30 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed January 24 2002. Claims 1, 3, 11, 13, 21, 23 and 24 have been amended.

Response to Argument

2. Applicant's arguments filed January 24 2002 have been fully considered but they are not persuasive.
3. The prior art Looney teaches the songs and other software if applicable, being tagged with a distinct serial number or other identifier and/or format that matches a pre-loaded serial number or format in the playback device. The serial number or format being pre-loaded in the playback device from software made available by the service provider. Applicant's specification, on page 12 lines 8-19, discloses the license comprising of a 32 bit group identifier or other identifiers sizes being used. The specification teaches the license management devices creating licenses having associated cardinality that determines the number of playback devices that can be authorized by the license and the license being caused to be stored in the playback devices. The number of playback devices that are authorized by the license can be one since the specification gives an example, on page 12 line 22 to page 13 line 1, where an individual obtains a license with a cardinality of one for personal use of digital content. Therefore, Looney's distinct identifier determines any playback device with matching identifier being authorized to play the digital content tagged with that identifier.

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Applicant argues that Looney does not teach the serial number or the license being stored by the playback device, in response to a license management device. Examiner disagrees. Looney teaches the serial number or format being loaded from software made available by service provider. Therefore, it is in response to the service provider (license management device) that the identifier is loaded in the playback device.

4. Applicant argues that the specification ^{does not} teaches managing the cardinality of a license. Applicant's specification discloses the license management device creating a license having an associated cardinality that determines the number of playback devices that can be authorized by the license. The specification, in page 12 line 15-19, describes the license comprising a 32 bit group (or more) identifier. And the license being caused to be stored in the playback devices. The specification does not teach whether the 32 bit group identifier is the same or not for every playback device or for every set of playback devices. The specification does not teach what is stored in the playback devices which ~~differentiate~~ ^{but} one set ~~from~~ ^{how} another.

Claim Rejections - 35 U.S.C. § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

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in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. Claims 1, 11, 21 and 24, failed to teach how the cardinality is implemented. The specification does not teach how the license determines the number of playback devices the license can be used to authorize the playback. Applicant's specification, on page 5 lines 13-22 and on page 6 lines 1-3, states that the license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license. The license is also included in digital content that the license authorizes for playback... Playback devices that have a license that matches a license included in the digital content are authorized to play.... And on page 12 lines 16-23, the disclosure states that the license comprises a 32 bit group identifier...Each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that include the license. The disclosure teaches that every playback devices that have the license stored are authorized to playback the digital content, whether they belong to a set of playback devices or not. The disclosure however fails to state or teach one of ordinary skill in the art how the cardinality indicates the number of playback devices authorized when the playback belongs to set of more than one playback devices. Since every playback devices storing a license belongs to a set of one

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playback devices storing the license, without this disclosure, one of ordinary skill can not practice the invention without undue experimentation.

8. Dependent claims 2-8, 10, 12-18, 20, 22, 23, 25-30 are rejected since they depend on rejected claim.

Claim Rejections - 35 U.S.C. § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-8, 10-18 and 20-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

11. Claim 1, 3, 11, 13, 21, 23 and 24, cite “transmitting, via a network connection the first license to a first set of playback devices”. Applicant’s specification discloses the license management device creating a license having associated cardinality... and the license management device causing the license to be stored in the set of playback devices. On page 14 lines 17-23, the specification discloses “The license is stored in a set of one or more playback devices at 630. In

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one embodiment, the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted.... The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device. Alternatively, the license can be stored in the set of playback devices in another manner". However the specification does not disclose the license being transmitted via the network. The management device causing the license to be stored in the playback devices and the management devices issues a command to the playback devices is not the same as and does not provide clear support for transmitting via a network connection the license to the playback devices. As a result, the claim contain subject matter which were not described in the specification in such a way as to reasonably convey to one skilled in the art that applicant had possession of the claimed invention.

12. Claims 2, 4-8, 10, 12, 14-18, 20, 22, 25-30 are rejected since they depend on rejected claims.

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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1, 2, 4-8, 10-12, 14-18
20-22, 24, 28-30

14. Claims 1-8, 10-18 and 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Looney et al. U.S. Patent No. 5,969,283.

15. As per claims 1, 2 and 4-6, Looney et al (Looney) disclose creating a license having cardinality, the license created by a license management device; storing the license in a set of playback devices in response to a command from the license management device; storing the license in a digital contents and authorizing playback of the digital content with the playback devices including the usage right (see col. 6 line 29 to col. 7 line 27 and col. 7 line 60 to col. 8 line 19). Looney implies that one playback device is authorized to playback the content. Therefore teaches that the license indicates the number of playback device that is authorized to playback the content.

16. Claims 7 and 8, are rejected as stated above in claim 1 and it is further noted that the playback device being a hardware or software is an inherent feature.

17. Claim 10 is rejected as stated above in claim 1.

18. Claims 11, 12 and 14-16 are rejected as stated above in claim 1.

19. Claim 20 is rejected as stated above in claim 11 and it is further noted that the playback device being a hardware or software is an inherent feature.

20. Claims 21 and 22 are rejected as stated above in claim 1.

21. As per claim 24, Looney et al. (Looney) disclose license having a first cardinality being created by a license management device, the digital data signal further comprising a first digital audio content that is at least a subset of a digital audio programming, wherein a set of playback

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devices receive the digital data signal and authorize playback of the first digital audio signal if the license included in the data signal matches at least one license stored in the respective playback devices (see col. 2 lines 51-58 and col. 7 lines 8-59). Looney also discloses licenses stored in a playback device. Looney discloses the digital audio signal (package of data compressed songs and other software if applicable being tagged with a distinct serial number or other identifier and/or format that matches a pre-loaded serial number or format in the subscriber's particular center (see col. 7 lines 9-27). Looney discloses compact disc player, DAT or other audio playback medium being used by the center and the center determining whether the appropriate identification code and/or serial number matching that of the center is present. If not the downloading of the disc is terminated. Looney implies that one playback device is authorized to playback the content. Therefore teaches that the license indicates the number of playback device that is authorized to playback the content.

22. Claims 28 and 29 are rejected as stated above in claim 24 and it is further noted that the playback device being a hardware or software is an inherent feature (see col. 3 lines 6-10).

23. As per claim 30, Looney disclose the first digital audio comprising digital Video programming (see col. 3 lines 6-10 and col. 15 lines 6-23).

Claim Rejections - 35 U.S.C. § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 3, 13, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Looney et al. U.S. Patent No.5,969,283, and further in view of Wyman U.S. Patent No. 5745879.

26. As per claims 3, 13, and 23, Looney does not specifically disclose at least one playback device belonging to a second set. Wyman disclose different nodes belonging to different accounts (see abstract and col. 1 lines 14-67). It would have been obvious to one of ordinary skill in the art at the time of applicant' invention to combine Looney's and Wyman's invention in order to provide flexibility or alternatives for varied licensing of parts or features of software packages as stated in Wyman (see col. 2 lines 18-34).

27. As per claims 25-27, Looney disclose access code authorizing the user's system playback the digital audio (see col. 2 lines 51-58). However it does not specifically disclose the cardinality being fixed, variable or unlimited, it is disclosed in Wyman (see col. 13 line 43 to col. 14 line 20). It would have been obvious to one of ordinary skill in the art at the time of applicant' invention to combine Looney and Wyman's invention in order to provide flexibility or alternatives for varied licensing of parts or features of software packages as stated in Wyman (see col. 2 lines 18-34).

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Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

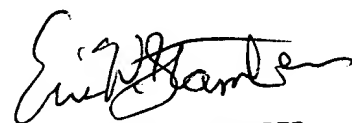
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or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Examiner
Yehdega Retta
Art Unit 2162
February 18, 2002